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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,346	12/30/2003	Daniel F. Justin	13447.40	8202

22913 7590 10/20/2006

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EXAMINER

STEWART, ALVIN J

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,346

Applicant(s)

JUSTIN ET AL.

Examiner

Alvin J. Stewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-28, 30, 31, 38-40, 42, 43, 45-47, 50, 55, 56 and 58-62 is/are allowed.
- 6) ☒ Claim(s) 14, 15, 18-21, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 14, 15, 18-21,23, 24, 26-28,30,31,38-40, 42, 43, 45-47,50, 55, 56, 58-63.

Response to Arguments

Applicant's arguments filed August 14, 2006 have been fully considered but they are not persuasive.

The new limitations entered to the claims substituting the cancelled claims do not place the case in condition for allowance. The new limitations are re-phrasing the previous functional language disclosed in the last amendment.

The new limitations do not place the Applicant's invention in a better position for overcoming the prior art. The Van Zile et al reference and the Albrektsson et al reference clearly disclose a bearing plate (22) having a stem (48) downwardly projecting from the bottom surface of the plate and that stem is capable of being permanently fixed to the bearing plate. If no need of removal, the stem can be capable of being permanently fixed to the bearing plate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Zile et al US Patent 5,019,103.

Van Zile et al discloses a condyle implant comprising a bearing plate (22) having a top articular surface (24) and an opposing bottom surface (62), a stem (48) downwardly projecting

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from the bottom surface of the bearing plate and means for connecting (see Figs. 1, 3 and 4) a fastener (50) to the stem.

Regarding claim 18, see Fig. 1.

Regarding claim 19, see col. 6, lines 53-55.

Regarding the new limitations in claim 14, the term “permanently fixed” was held not to be limited to a fabrication of the parts from a single piece of material, but was inclusive of other means of maintaining the parts fixed together as a single unit. In re Larson et al., 340 F 2d 965, 144 U.S.P.Q. 347 (C.C.P.A. 1965). The word “permanently fixed” is sufficiently broad to embrace constructions united by such means as fastening and welding. In re Hotte, 475 F 2d 644, 177 U.S. P.Q. 326 (C.C.P.A. 1973).

Regarding claim 55, the elongated fastener is element 76 and the tubular bone anchor is element 48.

Claims 14, 21, and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Albrektsson et al US Patent 6,102,954.

Albrektsson et al discloses a condyle implant comprising a bearing plate (30) having a top articular surface and an opposing bottom surface, a stem (20) downwardly projecting from the bottom surface of the bearing plate and means for connecting (threaded-spiral surface) a fastener (21) to the stem. The stem is removably encircling at least a portion of the fastener (see Fig. 10).

Claims 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Ek US Pub. 2004/0106928.

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Ek discloses a condyle implant comprising a bearing plate (20) having a top articular surface (31) and an opposing bottom surface, a stem (21) downwardly projecting from the bottom surface of the bearing plate and means for connecting a fastener (22) to the stem.

Regarding the new limitations in claim 14, the term “permanently fixed” was held not to be limited to a fabrication of the parts from a single piece of material, but was inclusive of other means of maintaining the parts fixed together as a single unit. In re Larson et al., 340 F 2d 965, 144 U.S.P.Q. 347 (C.C.P.A. 1965). The word “permanently fixed” is sufficiently broad to embrace constructions united by such means as fastening and welding. In re Hotte, 475 F 2d 644, 177 U.S. P.Q. 326 (C.C.P.A. 1973).

Allowable Subject Matter

Claim 63 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 26-28, 30, 31, 38-40, 42, 43, 45-47, 50, 55, 56 and 58-62 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Stewart
ALVIN J. STEWART
PRIMARY EXAMINER
Art Unit 3738

October 06, 2006